

REMARKS

1. Summary of the Office Action

Claims 1 – 52 are pending in the application.

Claims 1 – 25 and 27 – 51 have been rejected under 35 U.S.C. § 101, for allegedly being directed to non-statutory subject matter.

Claims 1 – 51 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1 – 52 have been rejected under 35 U.S.C. 102(b) or 103(a), as allegedly being anticipated by, or obvious in view of, U.S. Patent No. 5,835,896 to Fisher et al. (hereinafter, Fisher).

2. Response to § 101 Rejection

The Examiner has rejected claims 1 – 25 and 27 – 51 under 35 U.S.C. § 101, for allegedly being directed to non-statutory subject matter. In particular, the Examiner has stated that claims 1 – 25 have no connection to the “technological arts” and claims 27 – 51 are directed to “disembodied data structure[s].” In accordance with the Examiner’s recommendation, Applicant has amended independent claims 1 and 15, as well as 27 and 41. In particular, claims 1 and 15 are now directed to a “computer-implemented” method, and claims 27 and 41 have been amended to include a “computing device.” Applicant submits that claims 1 – 25 and 27 – 51, as amended, are directed to statutory subject matter and the rejection under 35 U.S.C. § 101 has been overcome.

3. Response to § 112 Rejection

The Examiner has rejected claims 1 – 51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

It should be noted that the operative standard for determining whether the definiteness requirement of the relevant statute has been met is “whether those skilled in the art would understand what is claimed when the claim is read in the light of the

specification.” The Beachcombers Intn’l, inc. v Wilde Wood creative products, Inc., 31 USPQ 2d 1653, 1656 (Fed. Cir. 1994) (citing Orthokinetics, Inc. v Safety Travel Chairs, Inc., 806 F.2d, 1565, 1 USPQ 2d 1081, 1088 (Fed. Cir. 1986)).

With respect to claim 1, the Examiner has suggested that the language, “when displaying information concerning the selected aspect...,” renders the claim indefinite. In addition, the Examiner has stated, “the claim is rendered unclear because the displaying of the note indicator is not positively recited as being carried out on a display unit.”

Applicant has amended the claim, in pertinent part, to read:

displaying a note indicator, on a display unit of a network device, to indicate an association of the administrative note with the administrator-selected aspect of the on-line auction when displaying information concerning the administrator-selected aspect on the display unit of the network device.

(Claim 1, as amended).

As amended, the claim states, in positive terms, that the displaying of the note indicator is “on a display unit of a network device.” Furthermore, Applicant submits that the language, “when displaying information concerning the selected aspect...” does not render the claim indefinite. One skilled in the art will recognize and understand that the claim relates to displaying a note indicator (e.g., icon, graphic, image or text) when displaying associated information concerning a selected aspect of the on-line auction (e.g., a user of the network-based auction facility, or, an item offered for auction). Consequently, Applicant submits that claims 1 – 14, as amended, are not indefinite under § 112, and the Examiner’s rejection has been overcome.

With respect to claim 15, the Examiner has stated that “the administrative note” lacks antecedent basis. Applicant has amended claim 15 to read:

A computer-implemented method of communicating administrative information concerning a user of a network-based auction facility, the method including:
automatically invoking a note creation function from one of a plurality of administrative applications of the network-based auction facility; and
generating an administrative note via the note creation function,

where the note creation function associates the administrative note with the user, as identified by an administrator of the network-based auction facility to the note creation function; and
storing the administrative note in a database.

(Claim 15, as amended). As amended, claim 15 includes “generating an administrative note.” Consequently, Applicant submits that claims 15 – 25, as amended, are not indefinite under § 112, and the Examiner’s rejection has been overcome.

With respect to claims 11 and 12, the Examiner has stated, “‘calling a note function’ ... is unclear because the parent claim does not support use of a computer program.” Applicant has amended the preamble of claim 1, the parent claim, to read:

A computer-implemented method of communicating administrative information related to the monitoring of a network-based auction facility, the method including:

(Claim 1, as amended).

Claim 1, as amended, is directed to a “computer-implemented” method. Accordingly, claim 1, as amended, supports the use of a computer program. Consequently, Applicant submits that claims 11 and 12, which depend from claim 1, are not indefinite under § 112, and the Examiner’s rejection has been overcome.

With respect to claims 13 and 14, the Examiner has stated “[the claims] are recited in improper form because they limit ‘the display’ which is not limiting any method step.” Applicant has amended claims 13 and 14 to read, “[t]he method of claim 1 wherein displaying a note indicator includes ...” Accordingly, as amended, claims 13 and 14 are in proper form. Consequently, Applicant submits that claims 13 and 14 are not indefinite under § 112, and the Examiner’s rejection has been overcome.

With respect to claims 16 – 25, the Examiner has stated that the claims do not further limit the parent claim, or alternatively, are not properly linked to the parent claim. Accordingly, Applicant has amended claims 16 - 23 to properly link the claims to their parent claim. Applicant submits that claims 24 and 25 are in proper form without an amendment.

With respect to claim 41, Applicant has amended the claim in accordance with the Examiner's suggestion. Applicant submits that the amendment to claim 41 overcomes the § 112 rejection.

4. **Response to § 102 and 103 Rejections**

The Examiner has rejected claims 1 –52 under 35 U.S.C. § 102(b) or 103(a), as allegedly being anticipated by, or obvious in view of, U.S. Patent No. 5,835,896 to Fisher et al. (hereinafter, Fisher).

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

i. **Fisher does not anticipate, or render obvious, independent claims 1, 26 and 27, because Fisher does not disclose each and every limitation of independent claims 1, 26 and 27.**

Claim 1, as amended, reads as follows:

A computer-implemented method of communicating administrative information related to the monitoring of a network-based auction facility, the method including:
generating an administrative note pertaining to an administrator selected aspect of an on-line auction facilitated by the network-based auction facility;
associating the administrative note with the administrator selected aspect of the on-line auction; and

displaying a note indicator, on a display unit of a network device, to indicate an association of the administrative note with the administrator selected aspect of the on-line auction when displaying information concerning the administrator selected aspect on the display unit of the network device.

(Claim 1). Claim 1 refers to generating an administrative note pertaining to an administrator-selected aspect of an on-line auction, and associating the administrative note with an administrator-selected aspect of an on-line auction, and then displaying a note indicator when displaying information concerning the administrator-selected aspect. Accordingly, when an administrator views a note indicator along with a particular aspect (e.g., user, auction item, etc.) of an on-line auction, then the administrator will know that an administrative note related to the particular aspect exists.

Fisher, on the other hand, discloses the following:

Auction manager 26 preferably frequently queries the bid database 31 to see if new bids have been placed. If new bids are found during the query, then auction manager 26 calculates the current high bidder or bidders and instructs merchandise catalog page generator 25 to regenerate a catalog page with the updated bid information.

(Fisher, Col. 7., Line 66 through Col. 8, Line 4). According to Fisher, the users of a network based auction system, electronically (e.g., via a computer) submit bids for items listed for auction. An auction manager (e.g., an administrator, or automated application) queries the bids and calculates, or determines, the highest bid. Then, the auction manager utilizes a merchandise catalog page generator to update a catalog page that displays the highest bid.

In contrast to claim 1, Fisher does not disclose generating an administrative note pertaining to an administrator-selected aspect of an on-line auction. As the Examiner has stated, Fisher discloses “regenerat[ing] a catalog page with the updated bid information.” However, a catalog page is not an administrative note. For example, Fisher does not disclose or suggest that a catalog page is associated with an administrator-selected aspect of an on-line auction. According to Fisher, an updated catalog page may include many aspects of an on-line auction. For example, auction information may be displayed on a

catalog page. However, Fisher does not suggest or disclose that a catalog page is associated with an administrator-selected aspect of an on-line auction.

Moreover, in contrast to claim 1, Fisher does not disclose or suggest displaying a note indicator to indicate an association of an administrative note with an administrator selected aspect of an on-line auction. The Examiner has suggested that Fisher discloses this limitation. In particular, the Examiner has referenced Figs. 2 and 3 of Fisher, and has stated that, “note indicators are presented as bid information and current high bidders with pertinent information.” However, bid information and the current high bidder, when displayed on a catalog page, may be aspects of an auction, but they are not note indicators. Fisher does not, for example, suggest or disclose that the high bidder indicates that a note exists and the note is related to the high bidder. For example, in contrast to the note indicator of claim 1, the current high bidder, when displayed on a web page, does not indicate an association of an administrative note with an administrator selected aspect of an on-line auction.

In view of the above, Applicant submits that Fisher does not disclose all of the limitations of claim 1 and, accordingly, claim 1 is allowable. As claims 2 – 14 depend upon claim 1, they are also allowable. For the same reasons, Applicant submits that claims 26 and 27 are allowable. As claims 28 – 50 depend upon claim 27, they are also allowable.

ii. **Fisher does not anticipate, or render obvious, independent claims 15, 26 and 27, because Fisher does not disclose each and every limitation of independent claims 15, 41 and 52.**

Claim 15, as amended, reads as follows:

A computer-implemented method of communicating administrative information concerning a user of a network-based auction facility, the method including:

 automatically invoking a note creation function from one of a plurality of administrative applications of the network-based auction facility;

 generating an administrative note via the note creation function,

 where the note creation function associates the administrative note with the user, as identified by an

administrator of the network-based auction facility to the
note creation function; and
storing the administrative note in a database.

(Claim 15). Claim 15, as amended, refers to generating an administrative note and storing the administrative note in a database.

Fisher refers to communicating auction information via email. Applicant submits that an automatically generated email is not the same as an administrative note, as claimed in claim 15. One skilled in the art will appreciate the differences between Applicant's invention, as claimed in claim 15, and an automatically generated email, as described in Fisher. For example, Applicant's specification (Background section) specifically describes several of the reasons why email is not a preferred method of communicating administrative information:

The administration a Web site, and specifically a commerce Web site, often demands that information concerning a user of tools and facilities provided by the Web site be communicated between various administrative personnel. It is important that the delivery mechanism for such information be reliable and up-to-date, as the failure to communicate information, or the miscommunication of information, may have very serious consequences for a commerce Web site.

While e-mail provides one mechanism commonly used for communications between administrative personnel, e-mail may not be a desirable solution due to the variety of the e-mail clients that may be employed by administrative personnel and problems with e-mail delivery.

Further, e-mail does not provide persistent or "sticky" information concerning an event concerning a user or item transacted via a commerce Web site.

(Applicant's Specification, Background Section).

Furthermore, claim 15, as amended, includes storing the administrative note in a database. In contrast to claim 15, Fisher does not disclose storing an administrative note in a database.

In view of the above, Applicant submits that Fisher does not disclose all the limitations of claim 15 and, accordingly, claim 15 is allowable. As claims 16 – 25 depend upon claim 15 they are also allowable. For the same reasons, Applicant submits

that claims 41 and 52 are allowable. As claims 42 – 51 depend from claim 41, they are also allowable.

In light of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 102 and 103 have been overcome, and withdrawal of these rejections are therefore respectfully requested.

5. Conclusion

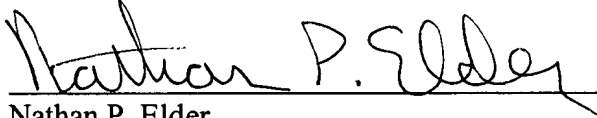
Having tendered the above remarks, Applicant respectfully submits that all rejections have been addressed and that the claims are now in a condition for allowance.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Nathan Elder at (408) 947-8200 ext. 207.

Respectfully submitted,

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Dated: November 9, 2004


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